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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/551,679
Filing Date: September 29, 2005
Appellant(s): PELLICONI, ANTEO

William R. Reid
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2 July 2009 appealing from the Office action mailed 29 January 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,586,531	Washiyama et al	7-2003

(9) Grounds of Rejection

The following ground of rejection is applicable to the appealed claims:

Claim Rejections - 35 USC § 102

Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Washiyama et al (US 6,586,531).

The applied reference has a common assignee and inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

The intended use of a masterbatch is with other constituents, including other polymers. The reference teaches the production of a masterbatch using crystalline polypropylene of "MFR[I] of from 0.5 to 10 g/10 min," present in an amount that embraces

the claimed range at 25% to 75%, with a second polymer faction having MFR^{II} embracing that recited herein at 15 to 100 g/10 min, and present in an amount that embraces the claimed range at 25% to 75%. Note the Abstract. Further, note column 3 (lines 33-42). When the MFR^{I} is equal to 0.5 g/10 min and the ratio of MFR^{II}/MFR^{I} is equal to 30, as taught by the reference, the value for MFR^{II} would be 15 g/10 min. At the taught ratio of 2000, the value for MFR^{II} would be 1000 g/10 min. When the MFR^{I} is equal to 10 g/10 min, and the ratio of MFR^{II}/MFR^{I} is equal to 30, the value for MFR^{II} would be 300 g/10 min. At the taught ratio of 2000, the value for MFR^{II} would be 20,000 g/10 min. The range is thus, from 15 g/10 min to 20,000 g/10 min. As such, the value for MFR^{II} would be from 15 g/10 min to 1000 g/10 min, which is within the range of "from 10 to 68 g/10 min.," as recited. Further, note column 6 (lines 26-42), column 7 (line 12) to column 8 (line 3), wherein the compositional limitations are taught, which clearly embrace those recited herein. The composition is employed to make molded articles. Note column 1 (lines 22 et seq.).

(10) Response to Argument

With regard to the rejection of claims 1-7 under 35 U.S.C. 102(e) as being anticipated by Washiyama et al (US 6,586,531), Appellants did not provide either a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or an appropriate showing under 37 CFR 1.131. Appellants argue, that since the reference compositions "embraces the claimed ranges, or "overlaps" the

claimed subject matter, the "Examiner appears to have applied a prima facie standard with respect to the overlapping ranges under §102." This is not the case since, when the reference composition meets the claim recitations at these points, the reference anticipates the claimed subject matter. Further, appellants argue, with respect to the claimed range of MFR^{II}/MFR^{I} (5-60), the reference shows a range of 30 to 2000 at column 3 (lines 39-41), and while "(t)he reference's broadest range is obviously much larger than that of the claimed range, and with it there is only a slight overlap," (t)here is no overlap at all with Washiyamas' (sic) most preferred range." Appellants further contend that "in Examples 1-6, Washiyama disclose MFR^{II}/MFR^{I} values of 200, 144.3, 83.3, 63.6, 466.6, and 520.0, respectively," and the lowest exemplified MFR^{II}/MFR^{I} ratio of 63.6 in example 4, is outside the claimed range." The scope of a patent document is viewed in the entirety of its teachings, not for isolated passages or Examples. With respect to the claimed values of MFR^{II} (from 10 to 68 [sic, g/10 min]), Appellants admit the reference does not provide a range for MFR^{II}, but provides "a ratio of MFR^{II}/MFR^{I} from which it can be calculated based on an MFR^{I} value." Appellants then contend "the calculated broadest range for Washiyamas' (sic) MFR^{I} is 15 to 20,000, with a calculated preferred range of 50 to 8000 (sic, g/10 min)." Appellants admit there is overlap of the MFR^{II} range, but argue since the "MFR^{II} values for Washiyamas' (sic) Examples 1-6 are 300, 140, 100, 70, 700, and 780 [sic, g/10 min], respectively," and "(t)he lowest exemplified MFR^{II} of 70 in Example 4 is outside the claimed range," "Washiyama do not describe the entire claimed ranges with sufficient specificity to meet the threshold requirements in order to anticipate these limitations of the present claims." The

recitation in the independent claim 1 of MFR^{II} having an upper value of 68 g/10 min is not deemed to be patentably distinct from that disclosed in the reference of 70 g/10 min. The disclosure thereof is deemed to provide support that the reference may, indeed, anticipate the claims, since the value is in line with the instantly claimed invention. The reference to Washayama et al teaches ranges for each of the MFR^{I}, MFR^{II}, MFR^{II}/MFR^{I} ratio and the compositional limitations that may, simultaneously, be the same. Where these components are the same as herein claimed, the reference is deemed to anticipate those claims. The ranges have identical points, and at these points the reference anticipates the invention. Again, the reference must be viewed in the entirety of its teachings.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Nathan M. Nutter/

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